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EXAMINER
SHRADER, LAWRENCE J

ART UNIT	PAPER NUMBER
2124	

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/727,524	CHEN ET AL.
	Examiner	Art Unit
	Lawrence Shrader	2124

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on _23 July 2004_.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) _1-28_ is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-28_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1.   This Office Action is in response to the amendment filed on July 23, 2004.

2.   Claims 1 – 28 remain rejected.

3.   Applicant's arguments with respect to claims 1 – 28 have been considered but are moot in

view of the new ground(s) of rejection.

Double Patenting

4.   The nonstatutory double patenting rejection is based on a judicially created doctrine
grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or
improper timewise extension of the "right to exclude" granted by a patent and to prevent possible
harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed.
Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686
F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA
1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
        A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to
overcome an actual or provisional rejection based on a nonstatutory double patenting ground
provided the conflicting application or patent is shown to be commonly owned with this
application. See 37 CFR 1.130(b).
        Effective January 1, 1994, a registered attorney or agent of record may sign a terminal
disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37
CFR 3.73(b).

5.   Claims 1 and 11 are provisionally rejected under the judicially created doctrine of double

patenting over claims 1 and 11 of copending Application No. 09/727,491. This is a provisional

double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

In reference to claim 1, this claim recites a method comprising: a) creating a multimedia file using an authoring tool; b) creating a text based description file to describe the multimedia content file; and c) combining the multimedia content file and the description file, all taught in claim 1 of the '491 application. The '491 application refers to a template in step b), however a template would be recognized by one skilled in the art as having a descriptive nature. Therefore, it would have been obvious to one skilled in the art to modify the '491 application to refer to a "template" rather than a "file descriptive of a multimedia content file" since a template is descriptive of the thing it is used to produce.

In reference to claim 11, this claim recites a method comprising: a) a processor receiving rich media; b) a means for assembling the rich media in a repository; c) generating a rich media content description file based on the repository file; and d) a means for combining the repository file and the description file. The '491 application refers to a template in step b), however a template would be recognized by one skilled in the art as having a descriptive nature. Therefore, it would have been obvious to one skilled in the art to modify the '491 application to refer to a "template" rather than a "generating a rich media content description file based on the repository file" since a template is descriptive of the thing it is used to produce.

Furthermore, there is no apparent reason why applicant would be prevented from

presenting claims corresponding to those of the instant application in the other copending

application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP

§ 804.

This is a <u>provisional</u> obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 102

6.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed
in the United States before the invention by the applicant for patent or (2) a patent granted on an application for
patent by another filed in the United States before the invention by the applicant for patent, except that an
international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this
subsection of an application filed in the United States only if the international application designated the United
States and was published under Article 21(2) of such treaty in the English language.

7.   Claims 1, 2, 7, 8; 11; 18 – 20, 24, and 25 are rejected under 35 U.S.C. 102(e) as being

anticipated by Gibbon, U.S. Patent 6,473,778.

Gibbon discloses a method to process rich media content:

In regard to claim 1:

*"creating a rich media content file from rich media content as a first input to an
authoring tool;"*

Gibbon discloses rich media file input to an authoring tool (column 3, lines 1 – 28).

*"creating a text based rich media content description file descriptive of the multimedia
content file as a second input to the authoring tool;"*

Gibbon discloses a description file (HTML) as input (column 13, line 53 to column 14,

line 7).

> *"combining the multimedia content file and the text based description file as a composed file using the authoring tools."*

Gibbon discloses the multimedia content file integrated with a text based description file

as a composed file (column 13, lines 53 – 62).

In regard to claim 2, incorporating the rejection of claim 1:

> *"...editing the rich media content description file by a user using a text editor."*

It is well known in the art that a description file is inherently textual (e.g., XML or

HTML), therefore it is editable by a using a text editor.

In regard to claim 7, incorporating the rejection of claim 1:

> *"...storing the composed file and the description file for access by one or more content creators."*

Gibbon teaches storage of the content file (e.g., see Figure 9 storage unit).

In regard to claim 8, incorporating the rejection of claim 1:

> *"...downloading the composed file for display to a user in an application."*

Gibbon teaches downloading the content file (e.g., see Figure 6).

In regard to claim 11:

> *"...a processor for receiving rich media;."*

The system taught by Gibbon includes a processor to receive rich media, text, and

graphics (e.g., Figure 9).

> *"means for assembling rich media as a combined multimedia vehicle repository (MVR) file;"*

See, e.g., Figure 9.

"means for automatically generating a rich media content description file based on an assembled MVR file;"

Gibbon discloses a description file (HTML) as input (column 13, line 53 to column 14, line 7).

"means for combining the MVR file and the description file..."

Gibbon discloses the integration of the rich media and descriptive files (column 13, line 53 to column 14, line 7; e.g., Figure 9).

In regard to claims 18, 19, 24, and 25:

Claims 18, 19, 24, and 25 (program code medium) are rejected for the same reasons put forth in the rejection of corresponding claims 1, 2, 7, and 8 (the corresponding methods).

In regard to claim 20, incorporating the rejection of claim 18 above:

Claim 20 (program code medium) is rejected for the same reasons put forth in the rejection of claim 3 (the corresponding method).

In regard to claim 28:

"generating a content file from rich media;"

Gibbon discloses rich media file input to an authoring tool (e.g., Figure 9).

"creating a text file descriptive of at least a portion of the rich media content file;"

Gibbon discloses a text file with a description file (HTML) as input (e.g., Figure 9).

"combining the content file and the text file into a composed file as an application executable on a media player."

Gibbon discloses the multimedia content file integrated with a text based description file

(HTML) as a composed file (column 13, line 53 to column 14, line 7).

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

9.   Claims 4, 12, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Gibbon, U.S. Patent 6,473,778, and further in view of Martens, U.S. Patent 4,570,221.

In regard to claim 4, incorporating the rejection of claim 1 above:

"...executing a batch processing program to combine the description file and the

multimedia content file."

Gibbon teaches the combining of a descriptive file and a rich media content file, but does

not teach executing a batch processing. However, Martens teaches the combining of files

executing a batch process (column 1, lines 25 – 28). Therefore, it would have been obvious to

one skilled in the art at the time the invention was made to combine two files, for example a

descriptive file and a rich media content file as taught by Gibbon, and incorporate the teaching of

Martens, because performing the combining with a batch process frees the user from the

execution details and also enables the process to run off-line as taught by Martens (column 1,

lines 25 – 28).

In regard to claim 12, incorporating the rejection of claim 11 above:

"a batch processing program running on the processor for combining..."

Gibbon teaches the combining of a descriptive file and a rich media content file, but does

not teach executing a batch processing. However, Martens teaches the combining of files

executing a batch process (column 1, lines 25 – 28). Therefore, it would have been obvious to

one skilled in the art at the time the invention was made to combine two files, for example a

descriptive file and a rich media content file as taught by Gibbon, and incorporate the teaching of

Martens because performing the combining with a batch process frees the user from the

execution details and also enables the process to run off-line as taught by Martens (column 1,

lines 25 – 28).

In regard to claim 21, incorporating the rejection of claim 18 above:

Claim 21 (program code medium) is rejected for the same reasons put forth in the

rejection of claim 4 (the corresponding method).

10.   Claim 5 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon,

U.S. Patent 6,473,778, and further in view of Murphy, U.S. Patent 6,564,380.

In regard to claim 5, incorporating the rejection of claim 1 above:

"...transmitting the rich media content as a streaming digital file."

Gibbon teaches collecting rich media content and combining with a descriptive file, but

does not teach transmitting the rich media content as a streaming digital file. However, Murphy

teaches the transmission of a stored digital file containing rich media content (video/audio feed;

column 6, lines 25 - 39). A stored video transmission is the result of a streaming digital file.

Therefore, it would have been obvious to one skilled in the art at the time the invention was

made to modify the teaching of Gibbon, which combines a descriptive file and a rich media

content, with the teaching of Murphy, which transmits the rich media content as a streaming

digital file, because this modification allows the rich media content of Gibbon to be fed as a

remote capture (rather than a live feed), thereby allowing a continuous feed of a saved input in

desired file formats as taught by Murphy (column 6, lines 30 – 35).

In regard to claim 22, incorporating the rejection of claim 18 above:

Claim 22 (program code medium) is rejected for the same reasons put forth in the

rejection of claim 5 (the corresponding method).

11.   Claims 6 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon,

U.S. Patent 6,473,778, and further in view of Mills, U.S. Patent 6,397,219.

In regard to claim 6, incorporating the rejection of claim 1 above:

"…using a graphical authoring tool to edit the rich media content;"

Gibbon teaches collecting rich media content and combining with a descriptive file with

an authoring tool, but does not explicitly teach a graphical authoring tool. However, Mills

discloses a graphical authoring tool (column 15, line 60 to column 16, line 16). Therefore, it

would have been obvious to one skilled in the art at the time the invention was made to modify

the authoring tool as taught by Gibbon, which combines a descriptive file and a rich media

content, with the graphical authoring feature as disclosed by Mills, because this modification

provides a means for the authoring tool of Gibbon easily access and efficiently edit Web pages,

as taught by Mills (column 15, lines 60- 67).

> *"creating a description file of the graphically edited rich media content."*

Gibbon discloses a description file (HTML) as input (column 13, line 53 to column 14,

line 7).

In regard to claim 23, incorporating the rejection of claim 18 above:

Claim 23 (program code medium) is rejected for the same reasons put forth in the

rejection of claim 6 (the corresponding method).

12.   Claims 9 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon,

U.S. Patent 6,473,778 in view of Murphy, U.S. Patent 6,564,380 as applied to claims 5 and 22

above, and further in view of Ohsuga et al., U.S. Patent 6,317,151 (hereinafter referred to as

Ohsuga).

In regard to claim 9, incorporating the rejection of claim 5:

> *"...generating the streaming digital file as a sequence of frames."*

Yamanaka teaches collecting rich media content and combining with a descriptive file,

modified by Murphy teaching the transmission of a streaming digital file containing rich media

content (video/audio feed). Although Murphy references the digital stream as a series of packets,

neither reference teaches that the generation of the streaming digital file specifically as a

sequence of frames. However, Oshuga teaches streaming video to a digital file as a sequence of

frames (column 1, lines 36 – 43). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine the teachings of Gibbon and Murphy to obtain a means to merge a descriptive file with a rich media content, and incorporating the generation of the rich media content as a streaming digital file in a sequence of frames as taught by Oshuga, because the digital frame allows the user to capture natural images and then edit them a reproducible digital format (see Oshuga, column 1, lines 36 – 42) that could be used as rich media content as taught by Gibbon.

In regard to claim 26, incorporating the rejection of claim 22:

Claim 26 (program code medium) is rejected for the same reasons put forth in the rejection of claim 9 (the corresponding method).

13.   Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon, U.S. Patent 6,473,778 in view of Murphy, U.S. Patent 6,564,380 as applied to claims 5 and 22 above, and further in view of Beckett et al., U.S. Patent 6,317,151 (hereinafter referred to as Beckett).

In regard to claim 10, incorporating the rejection of claim 5:

"generating the streaming digital file as a binary file ... "

Gibbon collecting rich media content and combining with a descriptive file, modified by Murphy teaching the transmission of a streaming digital file containing rich media content (video/audio feed). Although Murphy references the digital stream as a series of packets, neither reference teaches that the generation of the streaming digital file as a binary file. However, Beckett teaches streaming digital files as a binary file (column 12, lines 35 – 38). Therefore, it

would have been obvious to one skilled in the art at the time the invention was made to combine

the teachings of Gibbon and Murphy to obtain a means to merge a descriptive file with a rich

media content, incorporating the teaching of the generation of the rich media content as a binary

file as taught by Beckett, because a binary file allows implementation in loadable execution

format thus minimizing the programming skills needed by the user, as taught by Beckett (column

12, lines 38 – 53).

In regard to claim 27, incorporating the rejection of claim 22:

Claim 27 (program code medium) is rejected for the same reasons put forth in the

rejection of claim 10 (the corresponding method).

14.   Claims 14 – 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon,

U.S. Patent 6,473,778 in view of Beckett et al., U.S. Patent 6,317,151 (hereinafter referred to as

Beckett).

In regard to claim 14:

"...means for receiving and storing rich media assets in a binary format..."

Gibbon teaches collecting rich media content and combining with a descriptive file

(column 4, lines 53 – 67), but does not explicitly teach receiving assets in a binary format.

However, Beckett teaches a means to store streaming digital files as a binary file in order to load

applications as an executable file (column 12, lines 35 – 38). Therefore, it would have been

obvious to one skilled in the art at the time the invention was made to combine the teachings of

Gibbon regarding the collection of rich media content, incorporating the teaching of Beckett

regarding the receiving and storage of rich media content as a binary file, because a binary file

allows implementation in loadable execution format thus minimizing the programming skills

needed by the user, as taught by Beckett (column 12, lines 38 – 53).

"means for preparing a textual description... "

Gibbon prepares a textual description (column 3, lines 18 – 28).

"means for combining the MVR file and MVR textual description... "

Gibbon discloses the authoring tool the combining of the rich media and descriptive files

(e.g., Figure 9).

In regard to claim 15, incorporating the rejection of claim 14:

"...wherein the text description is XML based. "

Gibbon integrates HTML to view text (column 13, line 53 to column 14, line 7).

However, it is well known in the art that XML is designed to describe data. Therefore, it would

have been obvious to one skilled in the art at the time the invention was made to integrate XML

in the Gibbon invention to provide a more robust data description capability.

In regard to claim 16, incorporating the rejection of claim 14:

"means for modifying the text description... "

Official notice is taken that a description file is inherently textual (e.g., XML or HTML),

therefore editable by a using a text editor.

In regard to claim 17, incorporating the rejection of claim 14:

"means for modifying the textual description using a standard text-editing tool. "

Official notice is taken that a description file is inherently textual (e.g., XML or HTML),

therefore editable by a using a text editor.

15.   Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gibbon,

U.S. Patent 6,473,778.

In regard to claim 3, incorporating the rejection of claim 1:

"using an XML program to create the description file."

Gibbon discloses using HTML to create a description file (column 13, line 53 to column

14, line 7). However, it is well known in the art that XML is designed to describe data.

Therefore, it would have been obvious to one skilled in the art at the time the invention was

made to integrate XML in the Gibbon invention to provide a more robust data description

capability.

In regard to claim 13, incorporating the rejection of claim 11:

"an XML program running in the processor for translating the descriptive text in the combining..."

Gibbon discloses using HTML for translating the descriptive text (column 13, line 53 to

column 14, line 7). However, it is well known in the art that XML is designed to describe data.

Therefore, it would have been obvious to one skilled in the art at the time the invention was

made to integrate XML in the Gibbon invention to provide a more robust data description

capability.

Response to Arguments

16.   Applicant's arguments with respect to claims 1 – 28 have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

17.   Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Shrader whose telephone number is (571) 272-3734. The examiner can normally be reached on M-F 08:00-16:30.
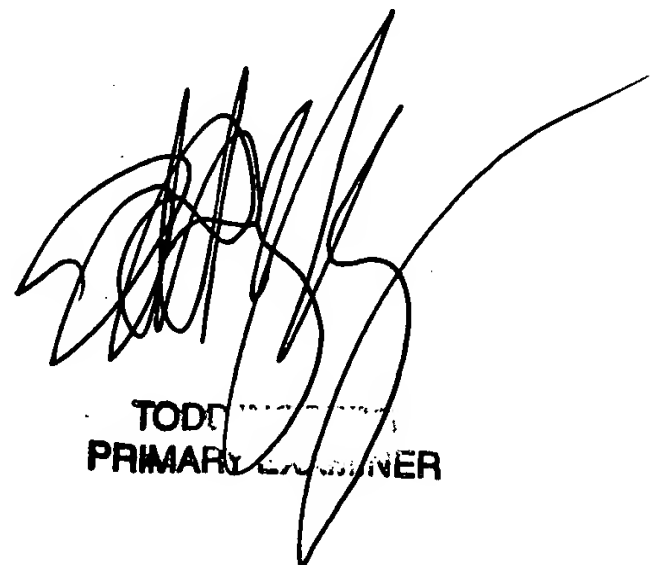
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lawrence Shrader
Examiner
Art Unit 2124

November 23, 2004

TODD
PRIMARY EXAMINER